

REMARKS

This is a full and timely response to the outstanding Final Office Action mailed March 26, 2008. The Examiner is thanked for the thorough examination of the present application. Upon entry of this response, claims 1-3, 5-14, and 20 are pending in the present application. Applicant respectfully requests consideration of the following remarks contained herein.

I. Response to Claim Rejections Under 35 U.S.C. § 103

The USPTO has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP §2141, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

For a proper rejection of the claim under 35 U.S.C. §103, the cited combination of references must disclose, teach or suggest all elements / features of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Claims 1-3, 5-14, and 20 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Brunkens* (EP 0 615 726 A1) in view of *Matsutani, et al.* (U.S. Patent No. 4,935,029, hereinafter

“*Matsutani*”). For at least the reasons set forth below, Applicant traverses the rejections.

Independent Claim 1

Applicant respectfully submits that independent claim 1 patently defines over *Brunkens* in view of *Matsutani* for at least the reason that the combination fails to disclose, teach, or suggest the features emphasized below in claim 1.

Claim 1, as amended, recites:

1. A suture needle comprising:
a shaft and a puncture tip at one end of a curve of the shaft,
wherein the shaft is marked with a visual indicator which
defines at least one of a front surface and a rear surface, and
wherein the visual indicator defines at least one of the front surface and the rear surface extending along the entire length of the shaft.

(Emphasis added.) Applicant has amended claim 1 in an attempt to further clarify the feature regarding the visual indicator recited in claim 1. No new matter is added by the amendment. Neither *Brunkens* nor *Matsutani* discloses, teaches, or suggests (individually or in combination) at least the feature emphasized above in claim 1.

In the prior non-final Office Action mailed September 25, 2007, the Examiner asserts that Applicant’s argument that it would not have been obvious to extend the visual indicator taught by *Matsutani* along the entire shaft “*might be persuasive.*”

(Non-final Office Action mailed September 25, 2007, page 6). The Examiner asserted, however, that the limitation of extending a visual indicator along the entire length of the needle is not claimed by Applicant. In an effort to advance prosecution, Applicant has thus amended claim 1 to now recite the limitation, “wherein the visual indicator defines at least one of the front surface and the rear surface extending along the entire length

of the shaft." Neither reference teaches at least this feature of claim 1. Moreover, it would not have been obvious to extend the visual indicator taught by *Matsutani* (i.e., "band 4" as referred to by the Office Action) along the entire shaft of the needle.

Applicant maintains that the welded portion (4) cited by the Office Action is not the same as the shaft recited in claim 1. It should be noted that the present outstanding Office Action again fails to address this argument in the "Response to Arguments" section. As emphasized by the Applicant in the prior response, the welded portion (4) of Matsutani is a separate component than the needle member (1). The needle member (1) and the pipe member (2) are formed of austenitic stainless steel and are welded together, resulting in the welded portion (4). It would not "have been obvious to extend the visual indicator (i.e., the welded portion (4)) along the entire shaft," as alleged by the Office Action. The *Matsutani* reference clearly makes the distinction between the welded portion (4) and the needle member (1). Indeed, the Abstract of the *Matsutani* reference states the following:

In a surgical needle, marks of welding are left as they are on a welded portion between needle and pipe members so that the welded portion has a surface distinguishable from peripheral surfaces of the respective needle and pipe members.

(Emphasis added). It would not be obvious to extend the welded portion down the length of the shaft because the purpose of the welding portion (4) is not to visibly distinguish between the front surface and the rear surface of the needle. Rather, the *Matsutani* reference teaches the following:

The ring-like welded portion 4 serves as a mark when, for example, the pipe member 2 is staked, so that it can be ensured that a part (designated by the character 2a in FIG. 5) of the pipe member 2 spaced a predetermined distance from the welded portion 4 is staked. This makes it possible to prevent occurrence of cracks or the like in the

pipe member 2 due to staking of the welded portion 4 or a part very close thereto. Moreover, the ring-like welded portion 4 serves also as a mark by which when a doctor clamps the surgical needle with a chuck jig at a surgical operation, he can clamp the surgical needle while keeping away from the pipe member 2 which is low in strength.

Col. 7, lines 17-30 (emphasis added).

In response to the allegation that it would have been obvious to extend the visual indicator (*i.e.*, welded portion (4)) down the entire length of the shaft, the *Matsutani* reference specifically teaches how the welding is carried out with respect to only predetermined angular extents along the abutting line 3 (in FIG. 7):

In each of embodiments shown respectively in FIGS. 12 through 15, welding is carried out with respect only to predetermined angular extents along the abutting line 3, in order to enable a surgical needle to have an especial function.

Col. 10, lines 11-15 (emphasis added). Therefore, if anything, *Matsutani* appears to teach away from extending the welding portion down the entire length of the needle. The U.S. Court of Appeals for the Federal Circuit has stated that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)) (emphasis added).

Thus, even assuming, *arguendo*, that the welded portion of the *Matsutani* reference is equivalent to the visual indicator in claim 1 (which Applicant submits it is not), it would not have been obvious to extend the welded portion taught by *Matsutani* along the entire shaft, as alleged by the Office Action.

Accordingly, Applicant respectfully submits that independent claim 1 patently defines over *Brunkens* in view of *Matsutani* for at least the reason that the combination fails to disclose, teach or suggest the highlighted features in claim 1 above. Furthermore, Applicant submits that dependent claims 2-3 and 5-10 are allowable for at least the reason that these claims depend from an allowable independent claim. See, e.g., *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for the allowability of claim 1, these dependent claims recite further features and/or combinations of features, as apparent by examination of the claims themselves, that are patentably distinct from the prior art of record. Hence, there are other reasons why these dependent claims are allowable.

Independent Claim 11

Applicant respectfully submits that independent claim 11 patently defines over *Brunkens* in view of *Matsutani* for at least the reason that the combination fails to disclose, teach or suggest the features emphasized below in claim 11.

Claim 11, as amended, recites:

11. A suture needle comprising:
a puncture tip; and
a shaft extending from the puncture tip, the shaft including means for distinguishing between a front surface of the shaft and a rear surface of the shaft, **wherein the means for distinguishing between the front surface and the rear surface of the shaft extends along the entire shaft.**

(Emphasis added.) Applicant has amended claim 11 to further clarify the feature regarding the means for distinguishing between the front surface and the rear surface recited in claim 11. On page 2, the Office Action collectively rejects a number of

claims, including independent claims 1 and 11. As an initial matter, Applicant respectfully objects as the claims are not co-extensive in scope.

Notwithstanding, Applicant has amended claim 11 only to further clarify the feature regarding the visual indicator recited in claim 11. No new matter is added by the amendment. Neither *Brunkens* nor *Matsutani* discloses, teaches, or suggests (individually or in combination) the limitation, "wherein the means for distinguishing between the front surface and the rear surface of the shaft extends along the entire shaft" and for at least this reason, claim 11 is patentable over the cited references.

Furthermore, dependent claims 12-14 are allowable for at least the reason that these claims depend from an allowable independent claim. See, e.g., *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for the allowability of claim 1, these dependent claims recite further features and/or combinations of features, as apparent by examination of the claims themselves, that are patentably distinct from the prior art of record. Hence, there are other reasons why these dependent claims are allowable.

Independent Claim 20

Applicant respectfully submits that independent claim 20 patently defines over *Brunkens* in view of *Matsutani* for at least the reason that the combination fails to disclose, teach or suggest the features emphasized below in claim 20.

Claim 20, as amended, recites:

20. A method of making a suture needle, comprising the steps of:
 - providing a suture needle; and
 - marking at least a portion of the suture needle with a visual

indicator, wherein the portion marked by the visual indicator extends the length of the suture needle, wherein the step of marking a portion of the suture needle comprises marking a surface of a shaft of the needle chosen from a front surface and a rear surface, wherein the front surface is the surface inside a curve of a shaft of the suture needle, and wherein the rear surface is the surface outside the curve of the shaft of the suture needle.

Applicant has amended claim 20 only to further clarify the feature regarding the visual indicator recited in claim 20. No new matter is added by the amendment. The Office Action concedes that the *Brunkens* reference fails to teach that its alleged front and rear surfaces are differentiated with a visual indicator. See Office Action, page 4. The Office Action, however, relies on the *Matsutani* reference to allegedly teach this feature. Applicant respectfully traverses the rejection and submits that neither *Brunkens* nor *Matsutani* discloses, teaches, or suggests (individually or in combination) the limitation, "wherein the portion marked by the visual indicator extends the length of the suture needle."

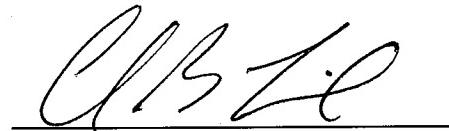
Accordingly, Applicant respectfully submits that independent claim 20 patently defines over *Brunkens* in view of *Matsutani* for at least the reason that the combination fails to disclose, teach, or suggest the highlighted features in claim 20 above.

II. Conclusion

Applicant respectfully submits that all pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,



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